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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,049	03/08/2001	Haakon Staalesen	Q63429	4247

7590

10/23/2002

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EXAMINER

CUEVAS, PEDRO J

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,049

Applicant(s)

STAALESEN, HAAKON

Examiner

Pedro J. Cuevas

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4/1, 4/2 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,166,349 to Williams et al. in view of U.S. Patent No. 4,774,855 to Murrell et al.

Williams et al. clearly teaches the construction of a system for operation of an electric generator from a main engine (5) having a varying rotational speed, comprising:

- a variable hydraulic pump (9) connected to and driven from the main engine,
 - a hydraulic motor (12) arranged to be driven by the hydraulic pump and to drive the electric generator (33),
 - a means (17) for regulating the oil quantity from the pump in dependence on supplied electric control signals, and
 - an electronic frequency controller (42) which is connected between a voltage output of the generator and the regulating means, and is arranged to deliver said control signals in dependence on frequency deviations on the generator output to thereby maintain the oil quantity from the pump, and therewith the generator frequency, constant.
- However, it fails to disclose system for operation of an electric generator from a main engine, on board of a sea going vessel, having a varying rotational speed.

Murrell et al. teach the construction of an apparatus having a transmission and multiple couplings on board of a sea going vessel for the purpose of providing an electrical generator with a constant rotational speed from a variable speed input.

It would have been obvious to one skilled in the art at the time the invention was made to use the apparatus disclosed by Murrell et al. on the a system for operation of an electric generator from a main engine disclosed by Williams et al. for the purpose of providing an electrical generator with a constant rotational speed from a variable speed input.

3. With regards to claims 2, 4/1, and 4/2, Williams et al. in view of Murrell et al. discloses a system wherein:

said regulating means (17) is constituted by a proportional valve converting an electric input signal to a hydraulic input signal influencing a servo piston, the servo piston being arranged to influence the pump displacement proportionally to said hydraulic input signal;

the frequency controller (42) comprises a processor unit (51) which is arranged to control the different functions of the frequency controller, and to be influenced by switches (i.e. Ignition Switch) and operating means (45) for adjustment of operational parameters of the frequency controller.

4. Claim 3 and 4/3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,166,349 to Williams et al. in view of U.S. Patent No. 4,774,855 to Murrell et al. as applied to claims 1-2, 4/1, and 4/2 above, further in view of common knowledge in the art.

Williams et al. in view of Murrell et al. discloses the claimed invention except for a system wherein a transformer is arranged between a voltage output of the generator and the

frequency controller, for transforming down the frequency signal from the generator to a desired voltage value.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a transformer between the output and input of any two different electronic devices which operate at different voltage levels, since it was known in the art that a transformer is designed to specifically step-up or step-down (depending on the connection) the voltage of a signal.

It should be emphasized that "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In *re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does." (emphases in original). To emphasize the point further, the court added: "An invention need not operate differently than the prior art to be patentable, but need only be different" (emphases in original).

5. Claims 5/1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,166,349 to Williams et al. in view of U.S. Patent No. 4,774,855 to Murrell et al. as applied to claims 1-2, 4/1, and 4/2 above, further in view of U.S. Patent No. 3,774,217 to Bonner et al.

Williams et al. in view of Murrell et al. disclose the system for operation of an electric generator from a main engine described above.

However, it fails to disclose a system wherein the frequency controller comprises a number of control switches for setting operational parameters of the frequency controller to desired predetermined values.

Bonner et al. teaches the use of a number of control switches (105) for the purpose of controlling mobile aerial platforms.

It would have been obvious to one skilled in the art at the time the invention was made to use the control switches disclosed by Bonner et al. on the system disclosed by Williams et al. for the purpose of controlling mobile aerial platforms.

Response to Arguments

6. Applicant's arguments filed August 8, 2002 have been fully considered but they are not persuasive.

7. In response to applicant's argument that Williams is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the system taught by Williams can be added to any type of transportation apparatus on which the act of welding can be done.

8. In response to applicant's argument that Williams does not teach a "variable" hydraulic pump, it must be noted that the fluid pressure on the disclosed pump will inherently vary according to engine speed and electrical load.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro J. Cuevas whose telephone number is (703) 308-4904. The examiner can normally be reached on M-F from 8:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Néstor R. Ramírez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-1341 for regular communications and (703) 305-3432 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Pedro J. Cuevas
October 21, 2002



KARL TAMAI
PRIMARY EXAMINER